

REMARKS

Claims 2-6, 11, 13-20, 25 and 28-86 are pending in the Application. The Office Action summary indicates that claims 2-6, 11, 13-25 and 28-86 are pending and that claims 12, 15, 16 and 18-25 are withdrawn from consideration. At page 2, the Office Action states that "claims 2-7, 11, 13-25, 28-86 are presented for examination." However, claims 7 and 21-24 were cancelled in a Preliminary Amendment filed January 3, 2001. The Examiner has maintained and made final the restriction requirement and acknowledged Applicants' election of the Group I claims, 2-6, 11, 13, 14, 17 and 28-35. Applicants believe that claims 36-86 are also included in Group I.

Claims 2-6, 11, 13, 14, 17 and 28-35 were rejected under the judicially-created doctrine of obviousness-type double patenting. The rejection is respectfully traversed as discussed below. Although the Office Action summary indicates that claims 2-6, 11, 13-25 and 28-86 were rejected, the Examiner provided no basis for rejecting claims 36-86.

For the reasons provided herein, Applicants submit that the pending claims are in condition for allowance and earnestly solicit notification to that effect.

Obviousness-Type Double Patenting Rejection

Claims 2-6, 11, 13, 14, 17 and 28-35 are rejected as unpatentable over U.S. Patent 6,150,346. At page 3, the Office Action states that the rejection is based upon U.S. Patent No. 6,130,346. However, because Applicants' prior patent 6,150,346 is both included with the Office Action and listed on the PTO Form 892 provided therewith, it is assumed that the intended citation should read 6,150,346.

The Office Action indicates that the pending claims are not patentably distinct from the '346 patent because the '346 patent claims 24-hydroxyvitamin D and 24-hydroxyprevitamin D compounds administered to treat diseases as claimed in the instant application. The Office Action further states that the difference between applicants' claims and the reference is various mechanisms of action which yield the desired effect.

Applicants respectfully traverse the rejection and request reconsideration thereof. The Office Action asserts that the claims of the cited patent and the claims of the instant application differ only by mechanism of action. At the outset, Applicants wish to emphasize that the present claims are not intended to be limited by any particular mechanism of action, and in fact, do not recite a mechanism of action.

Furthermore, the pending claims are directed to methods employing different vitamin D compounds having structures distinct from those disclosed and claimed in the '346 patent. The '346 patent, which is not related to the present Application through a claim of priority or otherwise, is directed to 1 α -hydroxyprevitamin D having the general formula shown at column 4, lines 40-55. The present claims are not directed to 1 α -hydroxyprevitamin D, but are drawn to methods including 24-hydroxyvitamin D or 24-hydroxyprevitamin D. In other words, the cited patent claims require hydroxylation at the 1 α carbon, whereas the present claims require hydroxylation at the C-24 position. Therefore, the cited patent does not teach or suggest the presently claimed compositions or methods.

Because the cited art fails to teach or suggest the compounds used in the claimed methods, the rejection under the doctrine of obviousness-type double patenting is improper. Applicants respectfully request withdrawal of the rejection and allowance of the presently pending claims.

Suggestion to Review Portfolio

In the Office Action, the Examiner requested that "applicants review their portfolio of patents and pending applications since the issue of double patenting may pertain to additional patents and applications therein," and urged an interview "to clarify this issue."

It is respectfully asserted that an interview is unnecessary. Applicants have fully complied with their duty of disclosure under 37 CFR 1.56 and submit that the record accurately reflects that the present claims are patentably distinct over the art of record. Should the Examiner have specific concerns with respect to any prior patent issued to Applicants, it is respectfully requested that such prior patent be made of record and Applicants afforded an opportunity to respond.

CONCLUSION

In view of the foregoing, reconsideration and allowance of claims 2-6, 11, 13, 14, 17 and 28-86 is respectfully requested. The Examiner is strongly encouraged to contact the undersigned by telephone should any issues remain with respect to the Application.

Please charge Deposit Account No. 50-0842 for any shortage or overpayment of any necessary fee associated with the filing of this information disclosure statement.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jill A. Fahrlander', with a long, sweeping horizontal line extending to the right.

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